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EXAMINER

MARKS, CHRISTINA M

ART UNIT PAPER NUMBER

3713

DATE MAILED: 06/19/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/904,385

Applicant(s)

RAVERDY ET AL.

Examiner

C. Marks

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, 5-6, 9, 11-23, 25-26, 29, and 31-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US Patent No. 5,779,549) in view of Walker et al. (US Patent No. 6,168,522) further in view of Peppel (US Patent No. 6,200,216).

Regarding claims 1 and 21, Walker et al. ('549) has created a system and a method for supporting a distributed electronic tournament (Abstract, line 1) or "electronic game" such as team play (Column 9, line 66), dexterity games (Column 10, line 13), golf (Column 10, line 33), trivia (Column 10, line 43), along with many other game formats that lend themselves to electronic online competition (Column 10, lines 9-11). This system comprises a central controller that serves as an event server that manages the tournament game services and provides restricted access to the game service over an electronic network only to users who have paid the

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required entry fee (Abstract, lines 4-9), thus restricting right of entry to the game not only in this manner but the system also prevents those players not qualified to play from participating in a certain tournament (Column 8, lines 55-56).

Furthermore, the system incorporates one or more user devices by means of I/O devices connected to the event server (Abstract, lines 1-4) and configured to communicate with the event server through a connection such as a wireless telecommunication network (Column 5, lines 21-22) thereby allowing one or more users to participate in the electronic gaming. As a means for a player to pay an entry fee, '549 has incorporated the ability to electronically communicate an electronic fund transfer, such as through funds from a bank account (Column 14, lines 52-57).

In US Patent No. 6,168,522, Walker et al. teaches that it would be desirable to allow fund or "ownership" transfer of balance between two parties for such reasons as two partners playing in a game and one runs out of money (Column 5, lines 15-30). Walker et al ('522) allows the user, playing on a user device, to perform a trading transaction with another user device (Column 5, lines 31-35) wherein the transaction is conducted directly between a source device and a target device (Column 5, lines 31-35). The user device is transferring rights to an "electronic certificate" (as defined by Applicant to include any type of authenticated digital data for example a game prize, membership information, a coupon or an object for use in a particular game). The transfer described in Walker et al ('522) is essentially a gaming prize as it is a representation of the balance accrued as the user has played and won on the gaming device (Column 5, lines 15-45). With ownership transfer available between two parties, one could transfer part of their balance to the other to allow the other to continue play (Column 5, lines 15-29) without interruption.

It would have been obvious to one of ordinary skill in the art at the time of invention to further the basic of funds transfer shown by '549 to the more advanced and elaborate fund transfer (and all features) of '522. By allowing users to not only transfer funds from a bank account as an entry fee, but also transfer funds from one another an entire new level of user-friendly convenience is added is incorporated into the system. By adding the teachings of '522 to '549, users would then have further capabilities of settling debts between one another, transferring funds to a team member during team play or transferring ownership rights obtained by winning a level of a game to another user for a variety of reasons. This transfer of balances and prizes as disclosed by '522 would especially be useful to the team embodiment disclosed in '549. By using the more advance funds transfer method of '549, users would be able to transfer funds and balances among team members having a common goal of victory. As disclosed by '522, it would be desirable to allow fund or "ownership" transfer of balance between two parties for such reasons as two partners playing in a game and one runs out of money. Thus, the incorporation of the functionality would be obvious to the disclosure of '549.

Furthermore, it would have been obvious to incorporate the functionality of providing a list of users to those who are currently active on the gaming system as shown in '522 in order to provide a means to allow active players to be able to "see" who is currently active to facilitate communication between said players and also allowing those who wish to transfer to "see" if their desired trading partner is currently active.

However, the combination of Walker et al. ('549) and Walker et al ('522) lacks allowing the users performing the transfer of the electronic certificate relating to a prize to negotiate the transfer before completing it.

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Peppel discloses an environment wherein users can directly trade between one another “rights” to an electronic card and negotiate the transfer between each other (Abstract). The method is used to enhance collecting, trading, and game playing (Column 3, lines 33-38) wherein the cards are essential and required in order to play the game. The cards have a plurality of data stored in them used in order to identify them (Column 3, lines 57-67; Column 4, lines 1-10). The cards are traded in an online environment wherein the trade can be accomplished through communication between users and wherein users can negotiate the trade (Column 8, lines 48-52). Peppel discloses that for something of value to be traded between two parties, negotiation is a part of agreeing upon a trade.

Based upon this disclosure of Peppel, it would have been obvious to one of ordinary skill in the art to incorporate a negotiation feature into the system as disclosed by Walker et al. (‘549 and ‘522). One of ordinary skill in the art would be motivated to make this incorporation in order to allow users to negotiate the trade and agree upon the trade before completing this as both systems involve the transfer of “rights” between two users. In application to the Walker et al patents, the ‘522 patent discloses the direct trading of electronic rights between partners. One of ordinary skill in the art would be motivated to incorporate the teachings of Peppel into the system of ‘522 so the users would be able to reach a complete agreement prior to completing the trade. An obvious agreement in application to the disclosure of ‘522 would be such as “if I provide you with these rights now, you agree to assist me at a later time if needed.” Further, one of ordinary skill in the art would be motivated to incorporate the teachings of Peppel into the system of ‘549 in view of ‘522 as ‘549 allows a user the “right” to advance further into a competition. It would have been obvious to one of ordinary skill in the art based upon the

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teachings of '522 and Peppel that this right is a commodity and could be exchanged between users as it also, like the rights traded in Peppel, is merely digital data. Therefore, one of ordinary skill in the art would be motivated to allow the users to negotiate a price for this item, as it has no fixed, known value and its value is intrinsically tied to what it is worth to someone who wants it and what it is worth to someone who wants to profit from it, thus adding a negotiation as disclosed by Peppel would have been obvious to one of ordinary skill in the art as the right to advance further into the competition is essentially a particular type of "certificate" used in gaming wherein the "certificate" is representative of the ability to move on in a game and thus would represent an advantage or completeness and based upon the disclosure of Peppel, thus can be traded.

In regards to claims 2 and 22, '549 has defined said I/O devices as a video gaming console, a personal computer, or a handheld electronic device and the like (Column 5, lines 12-15).

In regards to claims 3 and 23, '549 incorporates a parameter of entry fee that restricts access to the particular tournament or electronic game (Column 6, 43-45). In another circumstance of restriction, the game will restrict one or more participants in a specified event if they have not qualified to participate (Column 8, lines 55-56).

In regards to claims 5 and 25, the listings provided are a generally accepted list of notoriously well-known parts and systems that a computer needs to function and would have been obvious to the combination of references disclosed above. Applicant admits in specification that these parts are only one embodiment of the user devices (page 10, lines 18-19) and alternate embodiments may readily be implemented using various components and

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configurations in addition to, or instead of, those discussed in conjunction with the embodiment (page 10, lines 26-28) thus noting that the specifics of what comprises the device are not critical to the structural makeup. In reference to the components of the device memory, Applicant admits same facts in that this is only one embodiment of device memory (page 13, line 6) and alternate embodiments exist and may readily include various other components in addition to or in place of the components listed in the embodiment (page 13, lines 15-18) thus noting that the specifics of what comprises the device are not critical to structural makeup and that all these parts listed are so well known in the art that they may be readily substituted for other similar parts. Thusly, they are not axiomatic for operation and their use would have been obvious to one skilled in the art at the time of invention. Further, this non-criticality is only support for the fact that the specifics that comprise the device are not critical to the structural makeup and functionality of the device. Further, all of these parts and functions are so well known in the art that they may be readily substituted for other similar parts and/or functionality. Therefore, these non-critical parts are not inherent to the functional operation of the claimed invention and their use and implementation would have been obvious to one skilled in the art at the time of invention.

Likewise, in regards to claims 6 and 26, the listings provided are a generally accepted list of notoriously well-known parts and systems that a computer needs to function and would have been obvious to one of ordinary skill in the art to the combination of references disclosed above. Applicant even states in specification that these parts are only one embodiment of the event server (page 17, lines 17-18) and alternate embodiments may readily be implemented using various components and configurations in addition to, or instead of, those discussed in

conjunction with the embodiment (page 17, lines 24-26) thus noting that the specifics of what comprises the device are not critical to the structural makeup. In reference to the components of the server memory, Applicant admits that this is only one embodiment of server memory (page 19, line 4-5) and alternate embodiments exist and may readily include various other components in addition to or in place of the components listed in the embodiment (page 13, lines 13-15). This admission notes that the specifics of what comprises the device are not critical to structural makeup and that all these parts listed are so well known in the art that they may be readily substituted for other similar parts. Thusly, they are not inherent for operation and their use would have been obvious to one skilled in the art at the time of invention. Further, this non-criticality is only support for the fact that the specifics that comprise the device are not critical to the structural makeup and functionality of the device. Further, all of these parts and functions are so well known in the art that they may be readily substituted for other similar parts and/or functionality. Therefore, these non-critical parts are not inherent to the functional operation of the claimed invention and their use and implementation would have been obvious to one skilled in the art at the time of invention.

In regards to claims 9 and 29, '549 details the utilization of user devices to access and register with said game service. The system allows the player to enter the game format that they prefer to play via the associate I/O device. This preference is the communicated to the central server, which registers the user. When the game is about to begin, the server sends a message to the player in order to remind the player that the game is about to begin, thus allowing the player to access the game at the desired time and not accidentally miss the event (Column 14, lines 3-9).

Furthermore, '522 teaches that the server can provide a list of players who are currently using gaming devices on the network (Column 5, lines 39-41).

In regards to claims 11 and 31, '549 details the utilization of user devices to pay the entry fees that are required for participating in the tournament. '549 states the preferred embodiment includes steps responsive to payment of an entry fee by a player allowing the player to participate in a particular tournament via an associated I/O device (Column 6, lines 3-6).

In regards to claims 12 and 32, '549 also shows that tournaments may be held contemporaneously with a live event (Column 12, lines 50-51) thus incorporating gambling activities of the electronic gaming not only to tournaments but to real-time activity. Such gambling activities named are slot machines and poker tournaments (Column 12).

In regards to claims 13 and 33, '549 incorporates a prize system into the gaming environment. The central controller accesses the tournament database to retrieve the pre-established performance levels for the awarding of prizes. The central controller then reviews the performance levels of each player relative to the requirements for awarding prizes and then updates the winning player's database record to reflect that awards have been allocated to them. The central controller then distributes the prizes to the user (Column 7, lines 61-67; Column 8, lines 1-5). A prize is essentially a certificate as it represents something that has been won relating to the game.

In regards to claims 14 and 34, '522 teaches to allow the transfer procedure to utilize the source user device (gaming machine) to transfer the remaining amount or "certificate" to a remote or target gaming device (Abstract, lines 7-11).

In regards to claims 15 and 35, the Applicant defines a certificate repository module as effective means for storing, managing, and accessing certificates—otherwise, a database. ‘549 incorporates the usage of a database to store player information that is generated as the player participates in games. This includes information regarding player payments and “rights.” When a payment is made, the player’s record in the database is updated to reflect the change (Column 6, lines 51-55). Though, a database of user information is axiomatic to the proper function of ‘522 it is not disclosed. However, ‘522 does disclose that the gaming device the user is playing can be connected to a network to allow the user to access the account information, including the credits and certificates (Column 4, lines 6-10). That which is disclosed between these two arts in addition to what is well-known in the art dictates that it is obvious that ‘522 must use a database and that this database stores data about the user and the user may at anytime access their own data, including information about there assets or certificates.

In regards to claims 16, 17, 19, 20, 36, 37, 39, and 40, Peppel discloses that users locate and connect with one another when desiring a trade (Columns 7-8). Peppel also discloses that a negotiation can occur and obviously the negotiation relates to satisfactory trade terms for the trade and inherently each user will accept the terms before agreeing to and completing the trade (Column 8, lines 48-52). Once the users negotiate a trade, it would be obvious to the system of Peppel that the user purchasing the card would then be given the proper ownership rights and further because this transfer occurs online as negotiated through two users it would be a transfer between the source and the target. These features would also be obvious to the system of Walker et al. (‘522 and ‘549) when applying the teachings of Peppel.

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In regards to claims 18 and 38, it is notoriously well known in the art that transfers involving monetary amounts or gaming functions must be highly secured in order to protect the money and promote the integrity of the game. Peppel discloses embodying a password as a means for a lock and key to limit access to the "certificate." In the application of Peppel to the Walker et al. patents, it would have been obvious to one of ordinary skill in the art to make sure adequate security means are also available before allowing the transfer. It would thus be obvious, as it notoriously well known, that if proper means were not in place, they must be instituted before allowing the transfer to occur in order to protect the funds of the user and integrity of the gaming machine.

In regards to claim 41, '549 use both software and hardware to implement the method steps (Abstract, line 23-24). It is shown above that the main control operation of the central controller is managing the game and the main control operation of the I/O devices is communicating with the central control. '549 further incorporates the functionality of these devices as being performed by program instructions in stating that the control of the I/O devices and the central controller are typically incorporated into software code (Column 5, lines 63-65), thus allowing the system to be managed by and communicated with through software. Further, it is notoriously well known in the art that the functionality of gaming machines and systems are stored on memory and carried out via program instructions used to control the system.

In regards to claim 42, the stated means in Walker et al. for managing a game service is that of the said central controller and the means for communicating with said controller is that of said user I/O devices.

Claims 4 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over '549 in view of '522 further in view of Peppel (US Patent No. 6,200,216) further view of Wiltshire et al. (US Patent No. 6,409,602).

What '549, '522, and Peppel disclose, teach, and/or suggest has been discussed above and is incorporated herein.

It is well known in the art to use combinations of LAN and Internet to access a server from a remote terminal. In solidifying this point, Wiltshire et al. (US Patent No. 6,409,602) teaches that communications pathways for a computer gaming system can be any combination (therefore including all direct and indirect paths) of electrical cables, optical fibers, RF links, IR links, and protocol interfaces such as LAN and WAN (Column 4, lines 1-3). Wiltshire et al. further includes global communication pathways, the Internet and the World Wide Web (Column 5, lines 31-32). Because it is well known in the art how information travels along a network and with the teachings of Wiltshire et al., it would have been obvious to one skilled in the art at the time of invention to incorporate the versatile and combination networks of Wiltshire et al. to the wireless networks of '549 and the transferring capability of '522 to create various means in which to construct a network and transfer rights between users while retaining the convenience of portability with a wireless base.

Claims 7 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over '549 in view of '522 further in view of Peppel (US Patent No. 6,200,216) further view of Horstmann et al. (US Patent No. 5,947,825).

What '549, '522, and Peppel disclose, teach, and/or suggest has been discussed above and is incorporated herein.

'549 provides means for users to register for the game of their choice by communicating through the I/O device to the central controller of the game service (Column 14, lines 3-5). The central controller of the game service manages the tournament (Abstract, line 4). In US Patent No. 5,947,825 Horstmann et al. teaches that in a system of interconnected video games a players auditory senses can be stimulated by incorporating a microphone into each user device in which the player may talk bi-directionally with other players and a pair of loudspeakers in which the player will be able to hear (Column 1, lines 49-51). Furthermore, '549 also shows of a way to credit user accounts when they have been awarded prizes based upon meeting a certain set of pre-selected requirements. The central controller accesses the tournament database to retrieve the pre-established performance levels for the awarding or prizes. The central controller then reviews the performance levels of each player relative to the requirements for awarding prizes and then updates the winning player's database record to reflect that awards have been allocated to them. The central controller then distributes the prizes to the user. (Column 7, lines 61-67: Column 8, lines 1-5). Finally the event server of '549 is capable of receiving uploads from user devices in the sense that they can upload certificates from bank accounts or credit cards in order to assure that they will be allowed to participate in said tournament (Column 7, 10-15).

It would also be obvious to one skilled in the art at the time of invention to incorporate the communication system described by Horstmann et al. to the basic communication of simple transfers as taught by '522 to the overall gaming system shown by '549 to bring a more sophisticated level of communication between gaming users in which they could actively talk in

real time, thus speeding up the process of any pending transaction, such as a trade, yet still be able to remotely, without having to actually meet face-to-face.

Claims 8 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over ‘549 in view of ‘522 further in view of Peppel (US Patent No. 6,200,216).

Peppel teaches that the data in a gaming card should have the following properties in order to support authenticity (Column 5, lines 10-12): header information that serves as a certification description that includes identification and authentication information (Column 5, lines 14-16) wherein the authentication information includes security information with means to exclude unauthorized persons from accessing the certificate (Column 5, lines 14-17) and data that is related to electronic gaming (Column 5, lines 29-31). The card also axiomatically possesses owner information, thus providing to ownership rights, as it is disclosed that the card is associated with the owner when it comes under certain queries (Column 8, lines 50-55).

Peppel does not disclose that the certificate includes information relating to usage and transfer history. Walker et al. (‘522) discloses that it is desirable that in order to prevent erroneous transfers, the source and remote device communicate data regarding the transfer to each other (Column 5, lines 45-57). This data is indicative transfer and usage history as it shows the amount transferred (Column 5, line 50) indicating the usage of the certificate was indeed for monetary purposes as well as identifying the machine (Column 5, lines 51) from which and to whom the transfer is associated with. As disclosed by Walker et al (‘522) this data is sent along with the “certificate” in the transfer. Peppel teaches that in order to authenticate a digital certificate, it is advantageous to store the data relating to the certificate within the certificate and

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discloses that the certificate should include pointers and a writeable area in order to associate with related data (Column 3, lines 55-67; Column 4, lines 1-10).

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the transfer history and usage data sent along with the trade as disclosed by Walker et al. ('522) as data in the certificate as disclosed by Peppel. One of ordinary skill in the art would be motivated to incorporate the data into the certificate as disclosed by Peppel as it would provide for all of the data in a single transmission thus reducing the risk of losing or crossing data. Further, one of ordinary skill in the art would be motivated to store the data relating to the certificate within the certificate in order to provide better authentication as disclosed by Peppel.

Claims 10 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over '549 in view of '522 further in view of Peppel (US Patent No. 6,200,216) further in view of Horstmann et al. (US Patent No. 5,947,825).

What '549, '522, and Peppel disclose, suggest, and/or imply has been discussed above and is incorporated herein.

In US Patent No. 5,947,825, Horstmann et al. teaches that in a system of interconnected video games a players auditory senses can be stimulated by incorporating a microphone into each user device in which the player may talk bi-directionally with other players and a pair of loudspeakers in which the player will be able to hear (Column 1, lines 49-51). Furthermore, Applicant states in specification for own invention that sound module may preferably include a headset device to be worn by user thus implying that the usage of the headset is non-critical and

only preferable thus the substitution for a loudspeaker would have been obvious to one skilled in the art.

It would also be obvious to one skilled in the art at the time of invention to incorporate the communication system described by Horstmann et al. to the basic communication of simple transfers as taught by '522 and gaming system shown by '549 to bring a more sophisticated level of communication between gaming users in which they could actively talk in real time, thus speeding up the process of any pending transaction, such as a trade, yet still be able to remotely, without having to actually meet face-to-face.

### *Response to Arguments*

Applicant's arguments with respect to:

- 1) Chandra reference fails to teach a substantial number of the claimed elements of the present invention,
  - 2) the references cited do not teach a trading transaction for negotiating a transfer of ownership rights of an electronic certificate that relates to a gaming prize,
  - 3) Chandra does not teach allowing the client devices to negotiate directly with each other,
  - 4) the electronic certificate is not related to a prize,
  - 5) claims 4 and 24 with respect to the Chandra reference in view of Wiltshire et al.,
  - 6) claims 7 and 27 with respect to the Chandra reference in view of Horstmann et al., and
  - 7) claims 8 and 28 with respect to the Ginter reference and what the Applicant asserts is disclosed by and what is not disclosed by the Ginter reference
- have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with regard to the assertion that the Examiner nowhere relates any teachings of the cited references to specific claim numbers and fails to specifically site any claimed language, has been fully considered but they are not persuasive. The Examiner asserts that the claims were all addressed in the first and other prior office actions with respect to their limitations with a number of specific reference and citations with relation to the prior art. These limitations have also been addressed above.

Applicant's arguments with regard to the assertion that the references cited by the examiner nowhere discuss or teach an "electronic certificate" which is described in substantial detail in the specification on pages 22-24 (page 8, lines 12-15), the examiner respectfully submits that the language used to describe the electronic certificate in the specification is permissive language and does not concretely define exactly what the Applicant is claiming to be an electronic certificate. On pages 22-24, Applicant loosely defines what an electronic certificate is saying it may include a variety of information but may contain more. The certificate may include any type of authenticated digital data for example a game prize, membership information, a coupon or an object for use in a particular game. Thus, the transfer teachings of Peppel et al. teach of the transferring of such an electronic certificate in that they allow an ownership right to an object (with the possibility to use that object in gaming) to be transferred between two users. An electronic card thus falls under the definition of electronic certificate given by the Applicant, as it is an object for use in a particular game. The transfer of ownership rights of this trading card or "electronic certificate" is taught in the Peppel reference (Abstract; Column 8, lines 57-52), Therefore, Applicant's argument is not persuasive.

In response to the Applicant's argument of the means plus function language in regards to claim 42 (page 8, lines 20-23; page 9, lines 1-8), the argument is conclusionary and no support is given for what is lacking. An all encompassing statement is given that does not specifically point out that which the Applicant states is not anticipated by or made obvious in view of the references. Therefore, such conclusionary arguments are not persuasive.

In response to the Applicant's argument that the cited references fail to teach, "wagers for gambling activities (page 9, line 16)," the examiner respectfully disagrees. Wagers for gambling activities are clearly taught in that a player must pay an entry fee to enter the tournament and the tournament can be based on games of luck or chance in which the player has no control over the progression. Such examples named are slot machines and poker tournaments (Column 12). One of ordinary skill in the art understands gambling activities to encompass activities in which a player bets on an uncertain outcome, as of a contest or playing a game of chance for stakes and both of these definitions are encompassed in the teachings of the '549 patent as stakes are rewarded to the winner of the tournament. Therefore, the argument that the references fail to teach wagers for gambling activities is not persuasive.

In response to the Applicant's argument that the examiner repeatedly listed elements as non-critical and thus the rejections are improper (page 10, lines 1-5), the examiner acknowledges that many items were noted as being non-critical in the office action. However, the non-criticality is only support for the fact that the specifics that comprise the device are not critical to the structural makeup and functionality of the device. Further, all of these parts are so well known in the art that they may be readily substituted for other similar parts. Therefore, these non-critical parts are not inherent to the functional operation of the claimed invention and their

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use would have been obvious to one skilled in the art at the time of invention. Applicants have never made any expressed representations in the drafting of the disclosure of what exactly the user device consists of. The words the Applicant has used to describe the invention have implicit representations dictating what elements are critical and non-critical, i.e. the use of permissive language for certain elements. The specification states that the user device may include a listing of parts but may include more. Criticality is a facet in the inquiry given by Graham v. John Deere with respect to ascertaining the differences between the prior art and the claimed invention.

In response to the Applicant's argument that the examiner repeatedly states that various claimed limitations are "well known" and appears to be taking Official Notice without expressly stating so (page 10, lines 9-11), the examiner reminds the Applicant that the examiner is not required to expressly use the term Official Notice (see MPEP 2144.03). Furthermore, in order for a challenge to the taking of Official Notice to be persuasive, said challenge must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the Official Notice (see MPEP 2144.03). In the instant case, Applicant has not provided information or argument and did not meet the burden required and therefore the argument is not persuasive. It is well known that a computer has a processor, a display, a memory, a sound module, user interfaces, and I/O ports. Further it is well known that those I/O ports can be network or wireless. It is also well known that the memory of the computer stores the application software as well as the operating instructions in order to carry out the purpose in which it was designed or programmed. In the instant application to the prior art of record, Walker et al. ('549) inherently possesses a profile module to keep track of players, a certificate

handling module in order to award players based on performance, and a trading module would be required as per the teachings of Walker et al. '522 in order for the transfers to occur. Though Walker et al. do not explicitly disclose the exact terminology of functionality of these parts, the Examiner asserts that a patent need not teach, and preferably omits, that which is well known (see MPEP 2164.01(a)) as would be true for these modules associated with basic operation of the system. Thus, the listing of program parts claimed by the Applicant, would be axiomatic to the functionality of '549 in view of Peppel. It is highly unlikely that Applicant could create the required reasonable doubt in regards to the listing of computer parts or the axiomatic nature of them.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**US Patent No. 6,471,068:** Discloses that which is desirable in a certificate including associated an electronic certificate with an owner and security to ensure the validity of the data.

**US Patent No. 6,510,513:** Security server that matches a digest of data with a certificate in order to aid in verification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael O'Neill, Acting SPE, can be reached on (703)-308-3484. The fax phone

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numbers for the organization where this application or proceeding is assigned are (703)-872-9302 for regular communications and (703)-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

*cmm*

cmm

June 11, 2003

*Michael O'Neill*

**MICHAEL O'NEILL  
PRIMARY EXAMINER**